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Serial No.: 09/145,690

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Charles J. Long, Jr.

Serial No.: 09/145,690

Filed: September 2, 1998

Group Art Unit: 3727

Examiner: Hylton, Robin/Cronin, Stephen

Our Ref: 97-106 CIP

SNAP-ON SCREW-OFF
CLOSURE

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Sir/Madam:

APPEAL BRIEF

Pursuant to 37 C.F.R. §§ 1.191 and 1.192, the Applicants hereby submit the following brief to the U.S. Patent and Trademark Office ("PTO") Board of Appeals and Interferences, in appeal of the Examiner's decision to finally reject Claims 1-25 of U.S. Patent Application Serial No. 09/145,690.

I.
Real Party In Interest

The real party in interest is International Plastics and Equipment Corporation, which is

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the assignee of U.S. Patent Application Serial No. 09/145,690.

II.
Related Appeals and Interferences

There are no related Appeals or Interferences.

III.
Status of Claims

Claims 1-25 are currently pending in U.S. Patent Application Serial No. 09/145,690:

1. Claims 1-25 were finally rejected and are on appeal:
 - (a). Claims 7, 8, 10, 12, 15, 16, 18 and 20 as dependent from Claim 1 are indefinite under 35 U.S.C. § 112, ¶2 in claiming an improper combination/subcombination.
 - (b). Claims 1 and 25 have been rejected under 35 U.S.C. § 102 as being anticipated by Molinaro, U.S. Patent No. 5,480,045.
 - (c). Claims 11, 13 and 14 have been rejected under 35 U.S.C. § 103 as being obvious in light of Molinaro in combination with Montgomery, U.S. Patent No. 5,379,610.
 - (d). Claims 1-6, 21, 22 and 25 have been rejected under 35 U.S.C. § 103 as being obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 and Sander, U.S. Patent No. 5,487,481.
 - (e). Claim 9 has been rejected under 35 U.S.C. § 103 as being obvious in light

of the prior art as applied to Claim 1 or 25, and further in view of Csaszar, U.S. Patent No. 4,343,408.

(f). Claims 11, 13 and 14 have been rejected under 35 U.S.C. § 103 as being obvious in light of the prior art as applied to Claim 1, 11/1 or 11/25, and further in view of Montgomery.

(g). Claims 17 and 19 have been rejected under 35 U.S.C. § 103 as being obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Repp, U.S. Patent No. 5,593,055.

(h). Claims 1, 21 and 23-25 have been rejected under 35 U.S.C. § 103 as being obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675.

2. Claim 7 as dependent from Claim 1 and Claims 8, 10, 12, 15, 16, 18 and 20 as dependent from Claims 6/4/3/2/1 and Claims 6/4/3/2/25 and the preceding claim dependent thereon (i.e., Claim 10 as dependent from Claims 8/6/4/3/2/1 and from Claims 8/6/4/3/2/25) were indicated to be allowable over the prior art if rewritten to overcome the 35 U.S.C. § 112, ¶2 rejections and to include the limitations of the base claim and any intervening claims.

IV. Status of Amendments

In the Amendment dated July 6, 2000, Claims 1, 7 and 8 were amended to overcome the 35 U.S.C. § 112, ¶2 rejection posed in the Final Office Action, while Claims 1, 22 and 25 were

amended to incorporate the limitations of Claims 21, 23 and 24, which were cancelled. Entry of these amendments was refused in an Advisory Action issued in response to the aforesaid Amendment. On August 18, 2000, Applicant filed a Petition to the Commissioner for entry of the aforesaid Amendment, which was forwarded to the Examiner for consideration in the Decision on Petition dated September 18, 2000. No subsequent decision on entry of the Amendment has yet been made.

For the purposes of this appeal, the Affidavits of Charles J. Long, Jr. and Dieter Sander Pursuant to 37 C.F.R. § 1.132, which accompany the Amendment filed February 4, 2000, were admitted into evidence.

V. Summary of the Invention

The present invention provides a closure with a thread configuration adapted for snap-on or screw-on application to a container neck finish. Preferably the closure and neck finish contain eight or nine mating continuous or discontinuous threads for this purpose. (See specification; at Figs. 1 and 1A; and at page 8, lines 8-15; and at page 11, lines 8-15; and at page 12, lines 15-20.)

The present invention preferably provides at least one annular sealing bead depending from the outer surface of the closure valve which are compressed against the inner surface of the container neck to form a seal as the closure is snapped onto the container neck. Optionally, sealing engagement between the closure and the mating portions of the exterior wall of the container neck may be further improved by including one or more annular sealing beads on the interior surface of the closure depending annular skirt. (See specification; at Fig. 3; and at page

11, line 16 through page 12, line 14.)

The present invention also preferably provides a plurality of elevated areas extending upwardly from the tamper-evident band in spaced relation to the bottom edge of the closure body to support the tamper evident band in resisting vertical movement imparted by insertion of the closure on the bottle neck, thereby protecting the frangible elements during assembly. The frangible elements connecting the tamper-evident band to the lower edge of the closure body may be configured to extend from these elevated areas as well as the non-elevated areas of the tamper-evident band to assist in preventing axial misalignment of the tamper-evident band relative to the annular depending skirt portion of the closure upon subjecting the closure to torquing forces during assembly to the container neck. (See specification, at Figs. 1A, 2 and 2A; and at page 9, lines 1-15.)

Additionally, the tamper indicating closure may include at least one arcuate projection extending around at least a portion of the tamper indicating ring arranged for registration with an annular locking flange on a container neck portion on which the closure is positioned. The closure is optionally provided with at least one member attached to the tamper-indicating ring which cooperates with the arcuate projection to assist in breaking the tamper indicating ring during removal of the closure from the container neck. The arcuate projection is held in place by the container neck as the member is pulled away from the arcuate projection during twist-off removal of the closure body to cause the tamper indicating ring to break at a weakened area. (See specification; at Figs. 4 and 5; and at page 9, line 16 through page 11, line 7.)

At least one and preferably a plurality of circumferentially spaced lugs optionally extend

from the exterior wall of the container neck to facilitate breaking the frangible elements on the tamper-evident band of the closure by engaging the frangible elements as the closure is twisted off the container neck following initial snap-on application. (See specification, at Figs. 1 and 1A; and at page 8, lines 1-7.)

Formal drawings corresponding to those filed in International Application Serial No. PCT/US98/22933 are being submitted herewith in Appendix "B" for the purpose of aiding in an understanding of the invention.

VI. **Issues**

- (a). Whether Claims 7, 8, 10, 12, 15, 16, 18 and 20 as dependent from Claim 1 are indefinite in claiming an improper combination/subcombination.
- (b). Whether Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045.
- (c). Whether Claims 11, 13 and 14 are obvious in light of Molinaro in combination with Montgomery, U.S. Patent No. 5,379,910.
- (d). Whether Claims 1-6, 21, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 and Sander, U.S. Patent No. 5,487,481.
- (e). Whether Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Csaszar, U.S. Patent No. 4,343,408.
- (f). Whether Claims 11, 13 and 14 are obvious in light of the prior art as applied to Claim 1, 11/1 or 11/25, and further in view of Montgomery.

(g). Whether Claims 17 and 19 are obvious in light of the prior art as applied to Claim 1 or 25, and further in view of Repp, U.S. Patent No. 5,593,055.

(h). Whether Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675.

VII.

Grouping of Claims

For the reasons set forth below, Claims 1-25 are all product claims which stand independently of each other.

VIII.

Argument

The Examiner has replaced the original prior art rejections in the initial Office Action with rejections that all rely on references: Molinaro, U.S. Patent No. 5,480,045; Montgomery, U.S. Patent No. 5,738,231; Kern, U.S. Patent No. 4,448,319; Sander et al., U.S. Patent No. 5,487,481; Csaszar, U.S. Patent No. 4,343,408; Repp et al., U.S. Patent No. 5,593,055; and Julian, U.S. Patent No. 5,056,675. In the final Office Action, the Examiner has withdrawn all of the previous bases for rejection of the claims and now asserts that (i) Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045; (ii) Claims 1-6, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 with Sander, U.S. Patent No. 5,487,481; (iii) Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25 in combination with Csaszar, U.S. Patent No. 4,343,408; (iv) Claims 11, 13 and 14 are obvious in

light of Molinaro or the prior art as applied to Claim 1, 11/1 or 11/25 in combination with Montgomery, U.S. Patent No. 5,379,910; (v) Claims 17 and 19 are obvious in light of the prior art as applied to Claim 1 or 25 in combination with Repp et al., U.S. Patent No. 5,593,055; and (vi) Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675. The Examiner has indicated that Claims 7, 8, 10, 12, 15, 16, 18 and 20 (as dependent from Claims 1 and 25) are allowable over the prior art and would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of base Claims 1 and 25 and any intervening claims.

It is respectfully submitted that all the claims are in a condition for allowance as being dependent upon Claims 1 and 25 which are allowable over the prior art of record.

-A-

Nonentry of Amendment dated July 6, 2000

1. Claim Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 7 and 8, and all other claims dependent on Claim 8 and Claim 1, for indefiniteness on the basis that the preamble of those claims is directed to a closure while the body of those claims positively introduces the projection structure of the container. Applicant respectfully traverses this rejection, on the basis that this method of claiming is perfectly acceptable as indicated by one of the cited prior art references, i.e., Molinaro, U.S. Patent No. 5,480,045, which claims a "*closure for use with a neck*" that recites

features of the closure in cooperation with recited elements of the neck (i.e., "...at least one second spiral thread configuration on said upper skirt portion shaped and positioned to slip past said at least one first spiral thread configuration and interengage when said closure is applied to said neck...") See Molinaro, U.S. Patent No. 5,480,045; at Claim 16.)

2. Claim Rejections under 35 U.S.C. §§ 102 and 103:

Molinaro, U.S. Patent No. 5,480,045, has been relied upon as the basis for an anticipation rejection of Claims 1 and 25 under 35 U.S.C. § 102 and as the basis for an obviousness rejection of Claims 9, 11, 13, 14, 17 and 19 under 35 U.S.C. § 103. (See Final Office Action dated 3/28/00; at ¶¶ 4, 5, 7, 8 and 9.) However, all rejections based on Molinaro cannot stand because that reference does not teach or suggest "[a] tamper indicating closure configured for snap-on or screw-on application to a container, said closure comprising ... a tamper indicating ring connected to said depending skirt by a **frangible element**." as required by all claims as dependent from Claims 1 and 25. Instead, Molinaro teaches a closure which **must be snapped** onto its container neck with the tamper indicating band **intact**. This is because of the presence of ratchet teeth **26** and **12** on the closure and container neck, respectively, which will not allow solely screw-on application of the closure with the tamper indicating band **25** intact. (See Molinaro; at Figs. 1-5 and at column 3, lines 55-67.) For the foregoing reasons, Molinaro is not an applicable reference and cannot be relied upon for properly rejecting Applicant's claims.¹ Moreover, even if

¹ See MPEP § 2141.01(a) ("in order to rely on a reference as a basis for rejection . . . the reference must . . . be in the field of applicant's endeavor or . . . reasonably pertinent to the problem with which the inventor was concerned"); see also MPEP § 904.01(c) (determination of

considered applicable, Molinaro cannot anticipate² or render obvious³ Claim 1 or 25 or any other pending claim of the present application, which all depend therefrom.,⁴ for the same reasons.

Kern, U.S. Patent No. 4,448,319 has been cited in combination with Sander, U.S. Patent No. 5,487,481 as rendering Claims 1-6, 9, 11, 13, 14, 17, 19, 21, 22 and 25 obvious under 35 U.S.C. § 103(a). (See Final Office Action dated 3/28/00; at ¶6-9). However, as explained in Applicant's response to the Initial Office Action, any rejection based on Sander is inapplicable because it does not disclose a container closure system capable of permitting snap-on application

analogous art "*depends on the necessary essential function or utility of the subject matter covered by the claims*"). See also Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, 21 F.3d 1068, 1071-72 30 USPQ.2d 1377, 1379-80 (Fed. Cir. 1994)(holding relied-upon references did not support rejection of obviousness because the trial court "*identified no reference that taught or suggested that [the elements of the claims] might be adapted to the [claimed combination] . . . when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination*")(alteration in original).

² See MPEP § 2131 (citing In re Bond, 910 F.2d 831, 832 (Fed.Cir. 1990))(for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be **identically shown** in that reference, and the elements must be arranged as in the claim under review); In re Paulsen, 30 F.3d 1475, 1478-79 (Fed.Cir. 1994)(to serve as the basis for a 35 U.S.C. § 102 rejection, the relied upon reference must contain **all** the limitations of the rejected claim); PPG Industries v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ.2d 1618, 1624 (Fed.Cir. 1996)("[t]o anticipate a claim [under 35 U.S.C. § 102] a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter").

³ See Motorola v. Interdigital Technology Corp., 121 F.3d 1461, 1471, 43 USPQ.2d 1481, 1489 (Fed.Cir. 1997)("[i]n order to render a claimed apparatus or method obvious, the prior art must **enable** one skilled in the art to **make and use** the apparatus or method")(citing Beckman Instruments, Inc. v. Productter AB, 892 F.2d 1547, 1551, 13 USPQ.2d 1301, 1304 (Fed.Cir. 1989)).

⁴ See In re Fine, *supra*, 837 F.2d at 1076 (dependent claims are allowable if independent claims from which they depend are allowable).

of the closure to the container during initial installation as required by the instant claims.

Instead, this reference discloses a closure which can only be screwed onto a container and thus does not enable the requirement of Claims 1 and 25 (and the claims dependent therefrom) for *"said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck"*. (See Sander; at column 3, lines 10-26. See also Declaration of Dieter Sander, appended as Exhibit "A" to Applicant's Amendment dated February 4, 2000.) The Examiner has apparently agreed that, for this reason, Sander is not an appropriate basis for rejecting the claims, as all of the previously asserted claim rejections relying on Sander have been withdrawn. Thus, for the same reasons as discussed in Applicant's response to the Initial Office Action, Sander cannot render the finally rejected claims unpatentable either (see footnotes 1 and 3, supra)⁵ (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(b).)

In addition, and contrary to the Examiner's assertion, Kern does not teach or enable a "snap-on" closure as claimed in the instant application to require *"an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration*

⁵ See MPEP § 2143.01 ("if the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious"). See also In re Gordon, supra, 733 F.2d at 901-02 (reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "if [the prior art reference were modified in the manner suggested] it would be rendered inoperable for its intended purpose. . . . In effect, [the relied-upon reference] teaches away from the board's proposed modification")(alteration in original).

*adapted for **engaging** an external thread configuration on the neck portion of said container by **snap-on** application during initial installation of said closure to said container neck".* The teachings of Kern clearly indicate that it cannot be completely installed by snap-on application. Instead, it only allows the threads of the closure to "*snap over the **first turn**" of the bottle threads "so that the **screw cap** takes up a proper level position and can be properly **tightened** on to the bottle or container"* by an additional screw-on action. (See Kern; at Abstract; and at col. 1, line 35 - col. 2, line 62). Moreover, Kern discloses that a gap 14 must exist in the screw-thread of the cap or it will not be possible to snap the cap onto the container. (See Kern; at col. 1, line 35 - col. 2, line 62; and at column 3, lines 25-63). For these reasons, Kern again cannot be installed without being threaded onto a container, and thus also does not teach or enable the claimed limitation requiring "*said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by **snap-on** application during initial installation of said closure to said container neck*". Thus, Kern is also inapplicable and cannot be relied upon to reject Claims 1-6, 9, 11, 13, 14, 17, 19, 21, 22 or 25, independent of the other bases for rejection of these claims or of each other. (see footnote 5, supra). (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(d).)

Moreover, all claim rejections based on Csaszar (see col. 2, line 30-52; col. 4, line 53 - col. 5, line 13) and Montgomery (see col. 1, lines 23-35; col. 3, line 56 - col. 4, line 26); are improperly asserted for these same reasons, as these references teach a closure which is initially installed by screw on action instead of a snap-on procedure and thus do not teach or enable the

claimed limitation requiring *"said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck"*. As a result, the rejection of Claims 9, 11, 13 and 14 cannot stand (independent of the rejection of Claims 1 and 25 from which they depend or of each other) because they are all based on the improper combination of Csaszar or Montgomery (or both) -- which are both initially threaded onto a container -- with one or more other references (see footnotes 1, 3 and 5 supra). (See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(c).)

Repp teaches away from the requirement of all of Applicant's pending claims for *"a tamper indicating ring connected to said depending skirt by a frangible element"*, by stating that *"[t]he cap 21 may be very forcefully removed from the neck 22 without first removing the lower skirt 65 by unscrewing the cap. . . . Hence, if the cap is screwed back on the neck, the fact that bridges 67 have been fractured may not be readily apparent. Alternatively, the lower skirt 65 may be removed from the cap 21 before the cap is twisted open. . . . The tear tab [74] provides means for removing the lower skirt"* (See Repp; at column 6, line 62 through column 7, line 11)(alteration in original). Thus, Repp teaches that lower skirt 65 may not be removed merely by "screw-off" action of the closure with respect to the container neck as is made possible by the *"frangible element(s)"* of Applicant's claimed invention. Instead, a tear tab 74 must first be used to tear the lower skirt 65 away from the closure instead of being removed by a screw-off action. The claimed invention operates under none of these constraints,, as a result the obviousness

rejections of Claims 17 and 19 based on Repp cannot stand, independent of the other rejections.⁶

(See Affidavit Pursuant to 37 C.F.R. § 1.132 of Charles J. Long, Jr.; appended as Exhibit "B" to Applicants' Amendment filed February 4, 2000; at paragraph 2(a).)

-B-

Entry of Amendment dated July 6, 2000

In the Amendment dated July 6, 2000, Claims 1, 7 and 8 were amended to overcome the 35 U.S.C. § 112, ¶2 rejection posed in the Final Office Action, while Claims 1, 22 and 25 were amended to incorporate the limitations of Claims 21, 23 and 24, which were cancelled. Entry of these amendments was refused in an Advisory Action issued in response to the aforesaid Amendment. On August 18, 2000, Applicant filed a Petition to the Commissioner for entry of the aforesaid Amendment, which was forwarded to the Examiner for consideration in the Decision on Petition dated September 18, 2000. No subsequent decision on entry of the Amendment has yet been made.

The Examiner has refused entry of the aforesaid Amendment, which was necessitated by

⁶ See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1552-53 (Fed.Cir. 1983)(*"proceeding contrary to [i.e., "teaching away" from] the accepted wisdom in the art . . . is "strong evidence of nonobviousness"*); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-80, 42 USPQ.2d 1378, 1383-84 (Fed.Cir. 1997)(same). See also In re Gordon, 733 F.2d 900, 901-02, 221 USPQ 1125 (Fed.Cir. 1984)(reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that *"[the relied-upon reference] teaches away from the board's proposed modification"*)(alteration in original); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ.2d 1596 (Fed.Cir. 1988)(same).

final rejection of the claims and was not earlier presented for that reason, based on the rationale that it (i) raises new issues that would require further consideration and/or search; and (ii) is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the Examiner contends that the amended Claims 1, 7 and 8 as proposed do not overcome the combination/subcombination rejection set forth in the Final Office Action dated March 28, 2000, and that the amendments raise new issues with respect to the combination of the closure and container. Applicant respectfully traverses this refusal to enter the amendments to Claims 1, 7 and 8, as they address the 35 U.S.C. § 112 rejections raised by the Examiner in the final Office Action and present no new subject matter. Instead, these amendments make changes of only an editorial nature that are intended to place these claims in a condition for allowance by overcoming those rejections. Furthermore, the refusal to enter these amendments is improper as both Claims 7 and 8 multiply depend from Claim 25 -- itself a combination claim to which the combination/subcombination rejection in the final Office Action is inapplicable.

Because they present no new matter, these amendments raise no issue of lack of proper disclosure or undue breadth. As a consequence, the 35 U.S.C. § 112 rejections raised in the final Office Action are considered to be "technical" in nature under the standards of the Manual of Patent Examining Procedure (MPEP), and Applicant's attempt to amend the claims to overcome these rejections should not be refused consideration on appeal if those amendments would otherwise place the application in a condition for allowance over the prior art. See MPEP § 706.03:

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Moreover, separate and apart from the amendments to Claims 7 and 8, the proposed amendments to Claims 1, 22 and 25 only incorporate the previously-examined limitations of cancelled Claims 21, 23 and 24 and thus raise no new issues. Moreover, these amendments in fact place the case in better form for appeal, by reducing the questions presented on prior art to the single consideration of whether the remaining claims are allowable under 35 U.S.C. § 103 in light of the combination of U.S. Patent No. 4,448,319 to Kern with U.S. Patent No. 5,056,675 to Julian, which was the only asserted basis for rejection of the cancelled claims over prior art. By eliminating all prior art issues except for one, the amendments must at the very least be considered to place the claims in a better form for appeal by materially reducing and/or simplifying the issues for appeal, and thus should be entered. See MPEP § 714.12 ("*[a]ny amendment that will place the case either in a condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 C.F.R. § 1.116(a).*")

If the Amendment dated July 6, 2000 is entered on appeal, Applicant's arguments with respect to the amended claims are as follows:

1. Claim Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 7 and 8, and all other claims dependent on Claim 8 and Claim 1, for indefiniteness on the basis that the preamble of those claims is directed to a closure while the body of those claims positively introduces the projection structure of the container. Applicant respectfully traverses this rejection based on the amendment to Claims 7 and 8 set forth in the Amendment dated July 6, 2000, which overcomes the rejection in no longer setting forth the container structure as a positively recited element. *See* Claims 7 [and 8], *infra* ("*[t]he tamper indicating closure of Claim 1 or 25 [or 6], wherein said frangible element is broken by a projection located on said container neck and configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.*")

This method of claiming is perfectly acceptable as indicated by one of the cited prior art references, i.e., Molinaro, U.S. Patent No. 5,480,045, which claims a "*closure for use with a neck*" that recites features of the closure in cooperation with recited elements of the neck (i.e., "*...at least one second spiral thread configuration on said upper skirt portion shaped and positioned to slip past said at least one first spiral thread configuration and interengage when said closure is applied to said neck...*") *See* Molinaro, U.S. Patent No. 5,480,045; at Claim 16.)

2. Claim Rejections under 35 U.S.C. §§ 102 and 103:

As dependent from Claims 1 and 25 as amended in the Amendment dated July 6, 2000, it

is respectfully submitted that all claims are now in a condition for allowance, as Claims 1 and 25 now incorporate the limitations of Claims 21, 23 and 24 to require:

"... a tamper indicating ring connected to said depending skirt by a frangible element; wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection."

It is believed that this amendment now places Claims 1 and 25 and all remaining claims (as dependent therefrom) in a condition for allowance, as the only basis for rejection of Claims 23 and 24 was the combination of Kern and Julian, where Julian was cited as disclosing the foregoing limitation added to Claims 1 and 25. Notwithstanding the inapplicability of Kern to the present claims for the reasons set forth above, Julian does not disclose a tamper indicating band having the claimed *"arcuate projection"*, but instead teaches only ratchet teeth 52 that do not allow rupture of the tamper indicating band in a manner equivalent to the claimed requirement that *"said arcuate projection is held in place by an **annular locking flange** on said container neck as said member is pulled away from said arcuate projection by twist-off removal*

*of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring **upward** to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection".*

Instead of allowing movement of the tamper indicating ring "**upward to cause breakage of said frangible elements and fracture of said weakened area**" as required by the instant claims, the ratchet teeth **52** cause the tamper evident band to stay stationary as breakage of the band occurs by circumferential (and not upward) movement of the main body of the closure to sever frangible elements **34/34'** and **50/50'** as shown in Figs. 4-7 of Julian:

Likewise, in the unthreading direction, the stop surfaces **54** of the band ratchet teeth **52** will engage the stop surfaces **60** of the container neck ratchet teeth **58 to prevent further rotation** of the tamper indicating band **30** relative to the container **24**.... Referring to Fig. 4 as the cap **12** is further turned in the unthreading direction after the band ratchet teeth **52** have engaged the container neck ratchet teeth **58**, the band **30 will remain stationary** with respect to the container neck, but the cap will **turn** relative to the band ... until the axially extending frangible webs **34** will become fractured as shown at **34'**.... Continuing rotation in the direction of the arrow as shown in Fig. 5 will further flex the permanent flexible web **36** so that [t]he circumferentially extending frangible webs **50** will now be put under fracturing tension so that additional **rotation** of the cap in the direction of the arrow as shown in Fig. 6 will fracture these webs as shown at **50'**. (See Julian; at column 5, lines 5-68; and at Figs.4-7.)

As with the prior withdrawn rejection of original Claims 21-24 based on Beck, U.S. Patent No. 5,215,204, permanent flexible web **36** in Julian does not assist in breaking tamper indicating ring **30** by pulling the tamper indicating ring **upward**. This distinction over Beck as drawn in

Applicant's response to the Initial Office Action was accepted as a basis for withdrawing the rejection, and applies equally to overcome the present obviousness rejection based on Julian (see footnotes 1, 3 and 5, supra). Moreover, this distinction would apply to render cancelled Claims 21, 23 and 24 patentable independent of the other claims in the event that the Amendment dated July 6, 2000 is not entered. Id.

In summary, the Examiner as a matter of law has not provided sufficient evidence to support his burden of establishing a *prima facie* case of unpatentability. Instead, in relying purely on his own opinion to draw the conclusion that the claimed features would have been obvious in light of the cited references without providing evidence in the prior art to support that conclusion -- especially evidence contained within the disclosure itself of any of these references i.e., by reference with particularity to relevant portions of the description showing that the modifications necessary to arrive at the claimed invention starting from these teachings would be desirable or could even be accomplished -- the Examiner has engaged in the type of "hindsight reconstruction" that is an impermissible basis for establishing obviousness.⁷

⁷ See MPEP § 2142 ("[w]ith regard to rejections under 35 U.S.C. § 103, **the examiner must provide evidence** which as a whole shows . . . [that] the reference teachings establish a *prima facie* case of obviousness"); MPEP § 2143.01 ("a statement that modifications of the prior art to meet the claimed invention would have been '**well within the ordinary skill of the art**' at the time the claimed invention was made . . . is **not** sufficient to establish a *prima facie* case of obviousness without some objective **reason** to combine teachings of the references")(citing Ex parte Levengood, 28 USPQ.2d 1300)(Bd.Pat.App.&Inter. 1993)("As adapted to *ex parte* procedure, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)] has been interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for [its] rejection of an application under 35 U.S.C. § 102 or 103. . . . [A]n examiner **cannot** establish obviousness by locating references which describe various aspects of a patent applicant's invention **without also providing evidence of the motivating force** which would impel one skilled in the art to do what the patent applicant has done" (alteration in original))(also citing In re Fine, supra, 837

In the Amendment dated February 4, 2000, the Declaration of Charles J. Long, Jr., the inventor in the present application and an officer of the assignee, was entered as evidence of the unobviousness of the claimed invention pursuant to 37 C.F.R. § 1.132. The Examiner has not challenged the factual basis for any of the statements in the affidavit, a fact which requires allowance of the claims, because the evidence of unobviousness supplied by the affidavit is uncontroverted by any other proof in the record from one of skill in the art.

F.2d at 1074-76 ("*[t]he relied-upon references*) disclose at most, that one skilled in the art might find it **obvious to try** the claimed invention. But whether a particular combination might be 'obvious to try' is **not** a legitimate test of patentability. The Examiner relies on hindsight to reach his obviousness determination. But this court has said '*[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher*'") (citing W.L. Gore & Associates v. Garlock, Inc., *supra*). See also In re Laskowski, 871 F.2d 115, 116, 10 USPQ.2d 1397, 1398 (Fed.Cir. 1989) (reversing Board of Appeals and Interferences affirmance of rejection based on obviousness since "*the mere fact that the prior art could be so modified would not [make] the modification obvious unless the prior art suggested the **desirability** of the modification*"); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ.2d 1780 (Fed.Cir. 1992) (same). See also In Re Bond, 910 F.2d 831, 834-35, 15 USPQ.2d 1566 (Fed.Cir. 1990) (rejecting a Board of Appeals and Interferences finding of obviousness where "*critical differences exist between the claimed invention and the [relied-upon] prior art*") (alteration in original).

For the foregoing reasons, Applicants submit that the present invention is not obviated by the teachings of the prior art, and that the patent application and of Claims 1-25 therein are in a condition for allowance. Reversal of the rejection is, therefore, respectfully requested.

Respectfully submitted,
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IX.
Appendix "A"

A. Nonentry of Amendment dated July 6, 2000

WHAT IS CLAIMED IS:

1. A tamper indicating closure configured for snap-on or screw-on application to a container, said closure comprising:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;
- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element.

2. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes an elevated area extending axially towards said depending skirt, wherein said elevated area defines a region of decreased ring spacing from said depending skirt.

3. The tamper indicating closure of Claim 2, further comprising a plurality of said frangible elements and said elevated areas, wherein at least one of said frangible elements is

connected to said depending skirt between two said elevated areas.

4. The tamper indicating closure of Claim 3, wherein at least one other said frangible element is connected to said depending skirt from an elevated area.

5. The tamper indicating closure of Claim 3 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

6. The tamper indicating closure of Claim 4 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

7 The tamper indicating closure of Claim 1 or 25, wherein said container neck additionally comprises a projection configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

8. The tamper indicating closure of Claim 6, wherein said container neck contains at least one projection configured for engaging said frangible elements to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

9 The tamper indicating closure of Claim 1 or 25, wherein said inner annular sealing flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

10. The tamper indicating closure of Claim 8, wherein said inner annular sealing

flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

11 The tamper indicating closure of Claim 1 or 25, wherein said annular depending skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

12 The tamper indicating closure of Claim 10, wherein said annular depending skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

13. The tamper indicating closure of Claim 11, wherein at least one said annular sealing bead engages a sealing bead on the exterior of said container neck finish.

14 The tamper indicating closure of Claim 11, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

15. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing bead on the exterior of said container neck finish.

16. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

17. The tamper indicating closure of Claim 1 or 25, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

18. The tamper indicating closure of Claim 12, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

19. The tamper indicating closure of Claim 17, wherein said thread leads are segmented.
20. The tamper indicating closure of Claim 18, wherein said thread leads are segmented.
21. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned.
22. The tamper indicating closure of Claim 21, wherein at least one said arcuate projection comprises a locking member extending radially inward from said tamper indicating ring at an angle to a plane normal with said tamper indicating ring.
23. The tamper indicating closure of Claim 21, wherein said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.
24. The tamper indicating closure of Claim 23, wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.
25. A tamper indicating closure configured for snap-on or screw-on application to a

container, said closure and container comprising in combination:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;
- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element.

B. Entry of Amendment dated July 6, 2000

WHAT IS CLAIMED IS:

1. A tamper indicating closure configured for snap-on or screw-on application to a container, said closure comprising:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;
- c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and
- d. a tamper indicating ring connected to said depending skirt by a frangible element;

wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and

wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off

removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.

2. The tamper indicating closure of Claim 1 or 25, wherein said tamper indicating ring includes an elevated area extending axially towards said depending skirt, wherein said elevated area defines a region of decreased ring spacing from said depending skirt.

3. The tamper indicating closure of Claim 2, further comprising a plurality of said frangible elements and said elevated areas, wherein at least one of said frangible elements is connected to said depending skirt between two said elevated areas.

4. The tamper indicating closure of Claim 3, wherein at least one other said frangible element is connected to said depending skirt from an elevated area.

5. The tamper indicating closure of Claim 3 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

6. The tamper indicating closure of Claim 4 wherein said elevated areas extending from said tamper indicating ring are of a known vertical height, and said frangible elements are of a height greater than that of said known height of said elevated areas.

7. The tamper indicating closure of Claim 1 or 25, wherein said frangible element is broken by a projection located on said container neck and configured for engaging said frangible

element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

8. The tamper indicating closure of Claim 6, wherein said frangible element is broken by a projection located on said container neck and configured for engaging said frangible element to disconnect said closure from said tamper indicating ring upon twist-off removal of said closure from said container neck.

9 The tamper indicating closure of Claim 1 or 25, wherein said inner annular sealing flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

10. The tamper indicating closure of Claim 8, wherein said inner annular sealing flange includes at least one annular sealing bead extending around a portion of said inner annular sealing flange and being configured for engagement with the interior surface of said container neck finish.

11 The tamper indicating closure of Claim 1 or 25, wherein said annular depending skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

12 The tamper indicating closure of Claim 10, wherein said annular depending skirt includes at least one annular sealing bead extending around a portion of said skirt and being configured for engagement with the exterior surface of said container neck finish.

13. The tamper indicating closure of Claim 11, wherein at least one said annular

sealing bead engages a sealing bead on the exterior of said container neck finish.

14. The tamper indicating closure of Claim 11, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

15. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing bead on the exterior of said container neck finish.

16. The tamper indicating closure of Claim 12, wherein at least one said annular sealing bead engages a sealing groove on the exterior of said container neck finish.

17. The tamper indicating closure of Claim 1 or 25, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

18. The tamper indicating closure of Claim 12, wherein said thread configurations contain eight or nine circumferentially spaced individual thread leads.

19. The tamper indicating closure of Claim 17, wherein said thread leads are segmented.

20. The tamper indicating closure of Claim 18, wherein said thread leads are segmented.

22. The tamper indicating closure of Claim 1 or 25, wherein at least one said arcuate projection comprises a locking member extending radially inward from said tamper indicating ring at an angle to a plane normal with said tamper indicating ring.

25. A tamper indicating closure configured for snap-on or screw-on application to a container, said closure and container comprising in combination:

- a. a closure top portion;
- b. an annular depending skirt extending from said top portion, said depending skirt having an internal thread configuration adapted for engaging an external thread

configuration on the neck portion of said container by snap-on application during initial installation of said closure to said container neck;

c. an inner annular sealing flange depending from said closure top portion in spaced relation to said depending skirt; and

d. a tamper indicating ring connected to said depending skirt by a frangible element;

wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and

wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection.

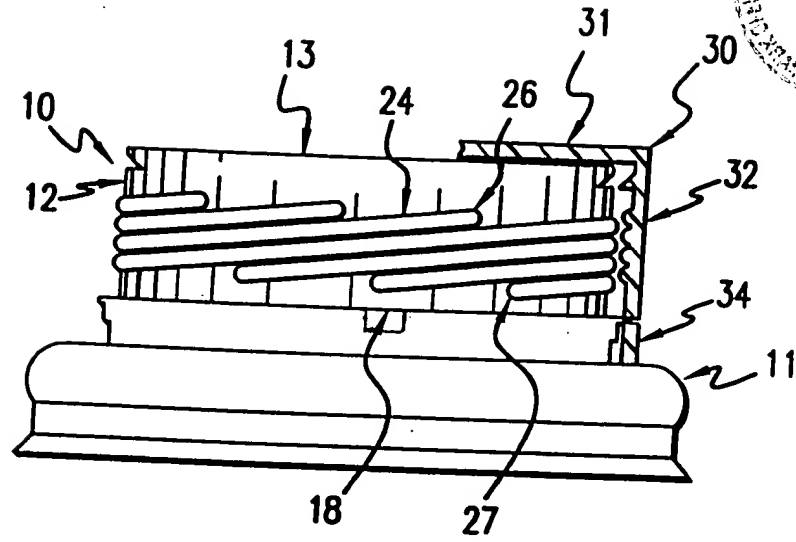


FIG. 1

no head

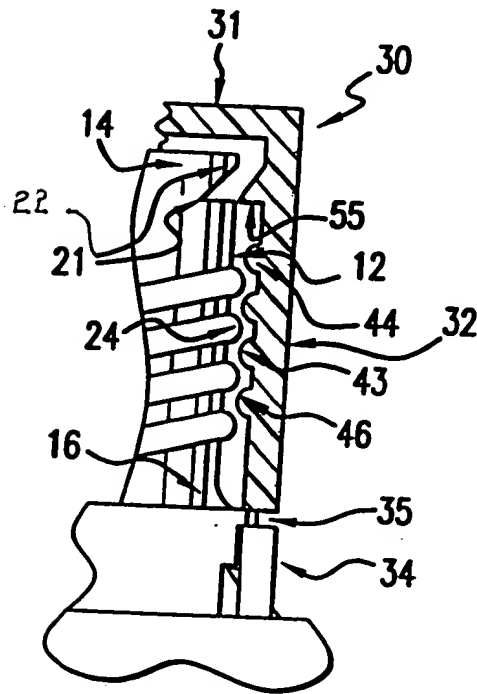


FIG. 1A

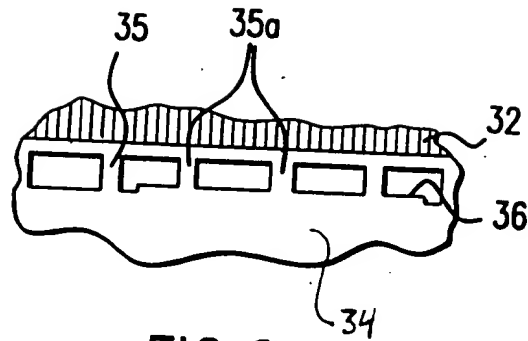
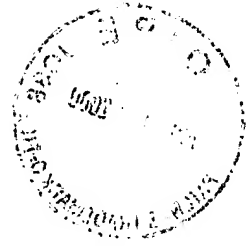


FIG. 2

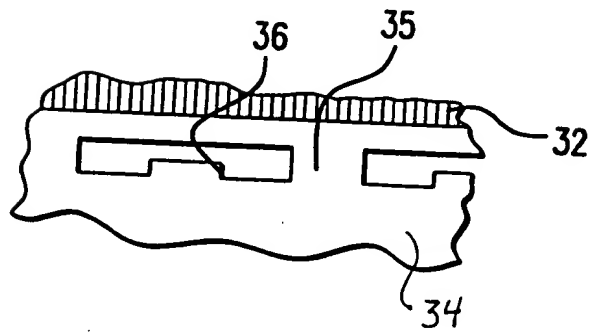


FIG. 2A

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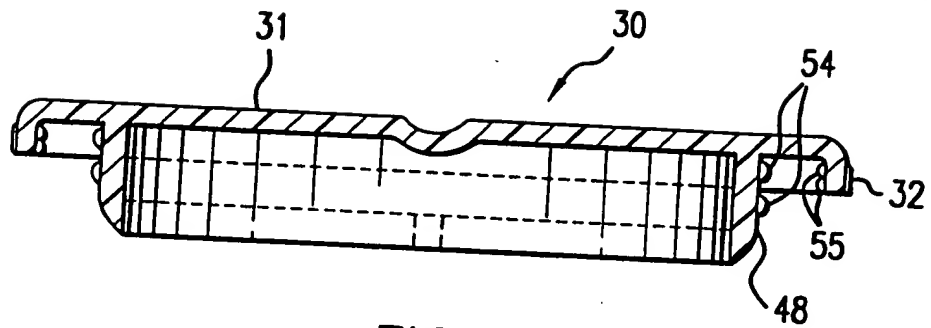


FIG. 3

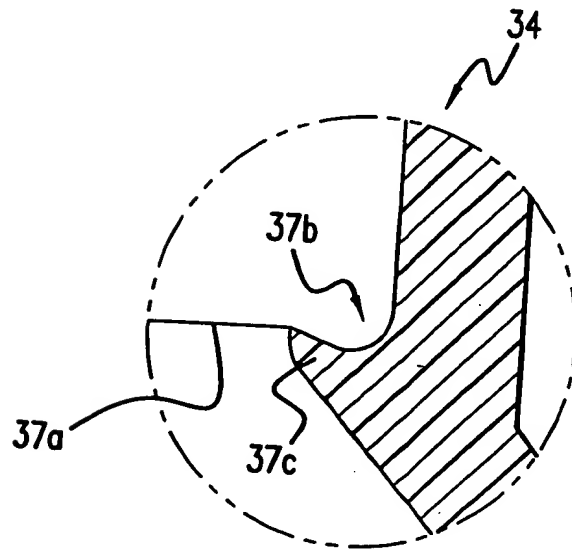


FIG. 4



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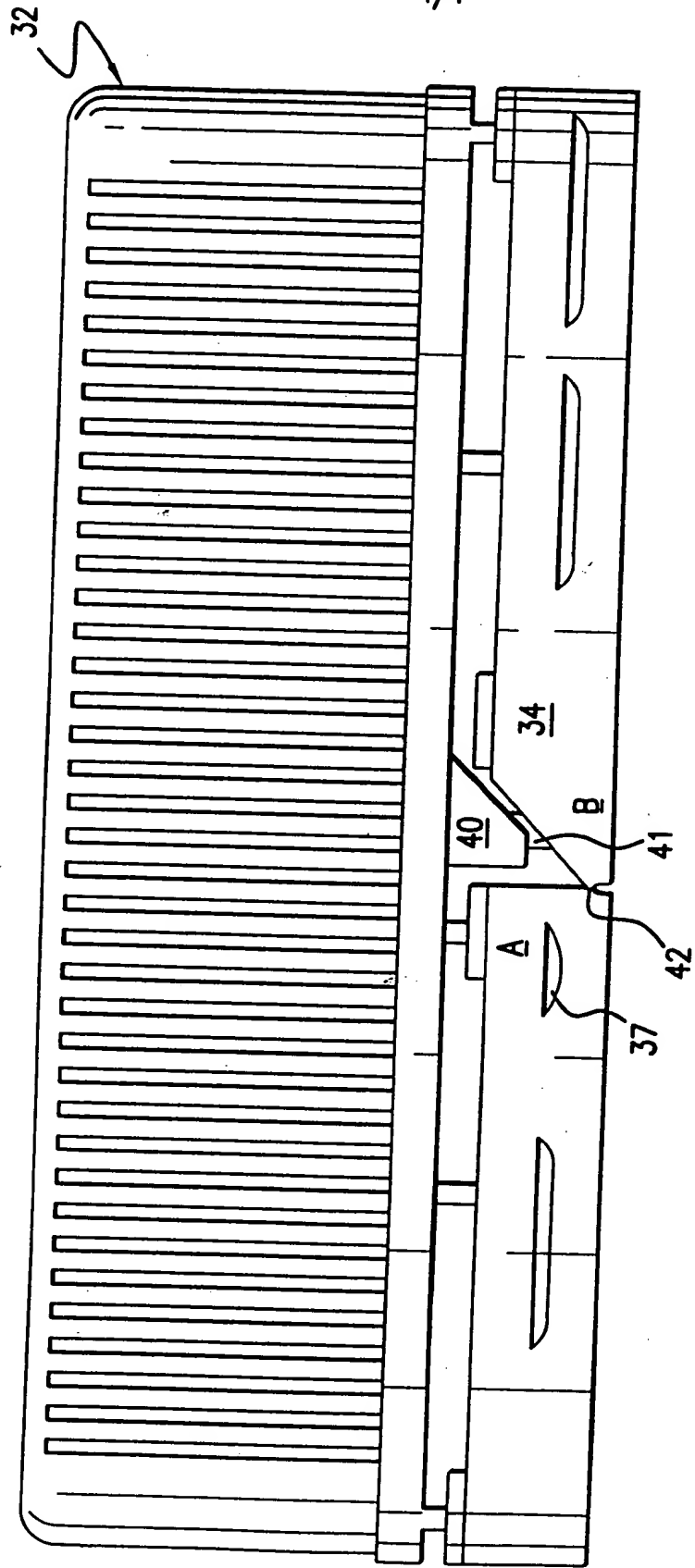


FIG.5